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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,655	03/26/2001	Ryuji Ueno	Q58513	5746

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SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
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WASHINGTON, DC 20037-3213

EXAMINER

FAY, ZOHREH A

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/816,655

Applicant(s)

UENO ET AL.

Examiner

Zohreh Fay

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

Art Unit: 1614

Claims 1-39 are presented for examination.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-39 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for certain eye disorders and certain diseases associated with apoptosis, does not reasonably provide enablement for all eye disorders associated with apoptosis and all diseases associated with apoptosis. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The factors to be considered in determining whether a disclosure meets the enablement requirements of 35 U.S.C. 112, first paragraph, have been described in *In re Wands*, 8 USPQ2d 1400 (Fed. Cir. 1988). Among these factors are:

1) The nature of the invention:

The claims are drawn to a method of treating an eye disorder associated with apoptosis or inhibiting apoptosis in a subject having a disease or disorder associated with apoptosis.

2) The state of the prior art:

The prior art does not recognize that all conditions associated with apoptosis can be treated with one group of compounds. According to *Lance* current Medical Diagnosis and Treatment, the treatment of AIDS, Alzheimer, inflammation and

Art Unit: 1614

retinitis is totally different and there is no one compound which can treat all the above disorders.

3) The relative skill of those in the art:

The relative skill of those in the art is high.

4) The predictability and unpredictability of the art:

The unpredictability of the pharmaceutical and chemical art is high.

5) The breadth of the claims:

The claims are very broad and encompass the use of prostaglandins for the treatment of any conditions associated with apoptosis.

6) The amount of direction or guidance presented:

Applicant's specification provides guidance and it is only enabled for using one prostaglandin in the treatment of apoptosis induced in retinal cells. However, the specification provides no guidance, to enable one of ordinary skilled in the art to use the invention commensurate in scope with the claims. In re Dreshfield, 110 F.2d 235, 45

USPQ 36 (CCPA 1940), gives this general rule: " It is well settled that in cases involving chemical and chemical compounds, which differ radically in their properties it must appear in an applicant's specification either by enumeration of a sufficient number of the members of a group or by other appropriate language, that the chemicals or chemical combinations included in the claims are capable of accomplishing the desired results".

Applicant's specification does not set forth a representative number of examples of prostglandins which are effective in treating any eye disorder associated with apoptosis or inhibiting any disorder associated with apoptosis.

Art Unit: 1614

7) The presence or absence of working examples:

The examples in applicant's specification are drawn to the use of one prostaglandin in treating retinal cells associated with apoptosis.

8) The quantity of experimentation necessary:

Since compound structure and activity for each pharmaceutical use must be determined from case to case by painstaking experimental study, one of ordinary skill in the art would be burdened with undue experimentation to determine all disorders associated with apoptosis which can be treated with prostaglandins.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 20-34 are rejected under 35 U.S.C. 102 (b) as being anticipated by The European Patent Application 0 435 443. The European Patent Application teaches the use of the claimed prostaglandins for the treatment of conditions associated with apoptosis. See page 3, lines 32-50.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zohreh Fay whose telephone number is (571) 272-0573. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (571) 272-0951. The fax phone

Art Unit: 1614

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Z.F

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